

## REMARKS

### I. Allowed Claim 16

Method claim 16 was allowed. None of the prior art references disclose a method of making a lens with lens surfaces that are bright pressed.

### II. Obviousness based on lwase, et al

Claims 8 to 15 were rejected as obvious under 35 U.S.C. 103 (a) over lwase, et al (US Patent 6,469,844 B1).

The subject matter of lwase, et al, is primarily a plastic lens holder, but there is disclosure in lwase, et al, regarding the lens to be held by the lens holder. See columns 3 and 4 and figures 1, 3A, 3B, 6A, 6B, where the lens is referred to as lens element 4 in lwase, et al.

lwase, et al, disclose a lens holder for a lens element 4 of a camera and a method of holding lens element 4 in the camera. The lens element 4 does have an outer flat flange 22 (equivalent to the holding edge 4) of the present application and a cylindrical flange 4c that extends downward from the bottom surface of the lens.

#### A. Lens Claims 8 to 13

However there are differences between the lens element 4 disclosed in lwase, et al, and the lens claimed in applicants' claims 8 to 13.

First, the lens element 4 is described in column 3, line 22, as a "positive power injection-molded resin lens" with a convex front surface. Thus the only lens disclosed in Iwase, et al, consists of a thermoplastic resin material.

A thermoplastic resin material cannot have "bright-pressed" surfaces as claimed in applicants' claim 8 because it cannot be bright pressed and is made of a different material than all embodiments of applicants' claimed lens. The reason the lens element 4 of Iwase, et al, cannot be bright pressed and is of a different material is that the thermoplastic resin material could not withstand the high temperatures used in the bright pressing method. A prior art reference, the Annual Report 1999 of "Fraunhofer Institut Werkstoffmechanik" describing molds for "bright pressing" is being filed with an Information Disclosure Statement. The reference states that the process temperatures used in "bright pressing" are 500°C to 700°C. Organic plastic resin materials cannot withstand these temperatures.

The requirement that the lens of claim 8 have surfaces that are bright pressed inherently excludes resin materials or organic plastic materials from the possible materials for the lens. Thus the lens claim 8 does not claim embodiments of the lens shown in the figures of Iwase, et al, and described as made of "resin material" in column 3, line 22, of Iwase, et al.

Only inorganic materials, such as glass, withstand the temperatures involved in bright pressing methods. Thus the lens of claim 8 is inherently limited to inorganic materials, such as glass. Other statements in the specification support this conclusion. For example, the statement that grinding and polishing

may be dispensed with because the lens surfaces are bright pressed is further evidence that the claimed lens is inherently made of inorganic material. Plastic lenses would not be subjected to grinding methods, because they are easily cast or molded at comparatively low temperatures. Also a plastic lens does not need a "cooling furnace" as disclosed on page 1 of applicants' specification. Furthermore the temperatures produced in projection headlights for automobiles are too high for plastic lenses and glass lenses are uniformly used in this sort of headlight.

It is respectfully submitted that the lens disclosed in applicants' specification is inherently limited to an inorganic material that can withstand the high temperatures used in bright pressing methods. Thus a reference that only discloses a lens made of organic resin or plastic materials cannot anticipate the invention claimed in claim 8. The disclosure in Iwase, et al, regarding the lens instead of the lens holder is limited to the particular lens disclosed in the detailed description in the specification of Iwase, et al, and shown in the figures of that reference, which is a plastic resin lens.

There is an additional difference between the lens made of inorganic material claimed in claim 10 and the lens shown in the figures of Iwase, et al. The supporting edge (5) is on the outer circumference of the lens, as shown in applicants' figure 1. This differs from the structure shown in figure 3 of Iwase, et al, in which the inside width of the base of the lens is smaller than its outer diameter, i.e. in which the "supporting edge" of Iwase, et al, is set back from the outer periphery or circumference of the lens so that the lens diameter is smaller there. In situations where there is only limited space for the lens, like the case of

projection headlights for vehicles, the lens structure of claim 10 provides a considerably advantage for mounting the lens in a holder that surrounds a somewhat bulky tungsten headlight lamp. For example, the set-back supporting edge 4c of the lens element 4 of lwase, et al, would prevent the broad front of a headlight lamp from being positioned as close as possible to the plane surface 3 of the lens 1 as shown in applicants' figure 1.

Thus the lens 1 limited according to claim 10 is better adapted to the projection headlight application because it permits a more compact projection headlight assembly. The features of claim 12 further promote the adaptability of the lens to the headlight application and further distinguish from lwase, et al, provided the lwase, et al, figures are "to scale".

It is well established by many US Court decisions that to reject a claimed invention under 35 U.S.C. 103 there must be some hint or suggestion in the prior art of the modifications of the disclosure in a prior art reference or references used to reject the claimed invention, which are necessary to arrive at the claimed invention. For example, the Court of Appeals for the Federal Circuit has said:

"Rather, to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant...Even when obviousness is based on as single reference there must be a showing of a suggestion of motivation to modify the teachings of that reference.." *In re Kotzab*, 55 U.S.P.Q. 2<sup>nd</sup> 1313 (Fed. Cir. 2000). See also M.P.E.P. 2141

There is no suggestion or motivation for one skilled in the art to replace

the plastic resin lens for the camera disclosed in Iwase, et al, by a glass lens or another lens made of inorganic material with bright pressed surfaces, because the plastic lens is more easily made and more economical for a camera, as shown in Iwase, et al.

Regarding claim 10, there is no reason to be concerned regarding the position of the supporting edge at the outer circumference in the lens of Iwase, et al, because a bulky light source is not required to fit up against the rear surface of the lens in the case of the camera application.

For the foregoing reasons it is respectfully submitted that Iwase, et al, does not establish a case of *prima facie* obviousness of lens claims 8 to 13.

#### B. Projection Headlight Claims 14, 15 and 17

Independent projection headlight claim 14 has now been amended to include lens holder structure as well as lens structure.

The lens holder of amended claim 14 embraces the holding edge on the side having the convex surface, i.e. the front surface. The holder of Iwase, et al, does not have a structure that embraces the holding edge on the side with the convex surface. Instead a caulking tool 5 is used to bend fixing claws 6a so that they are deformed and bear on the lateral sides or edges of the lens, as shown in figs. 3a and 3b.

Furthermore the lens holder of Iwase, et al, does not have the cylindrical wall with the inwardly directed flaps 12 for engaging under the lens and for securely holding the lens in the lens holder 10.

Also the lens holder of Iwase, et al, is plastic, and not made of sheet metal as claimed in claim 14.

The modifications of the lens holder of Iwase, et al, to obtain or arrive at the lens holder 10, as claimed in amended claim 14, are not suggested in the art because the respective applications are entirely different. The lens holder 10 of applicants' amended claim 14 is adapted to the headlight application and particularly securely holds the lens even in the event of impacts to the vehicle. The plastic lens holder of Iwase, et al, does not need to withstand impacts and does not engage around the lens in the same manner as applicants' holder 10.

The structure of the lens holder 10 of applicants' amended claim 14 would not be obvious to one skilled in the art from disclosure of the lens holder in Iwase, et al.

New headlight claim 17 claims a headlight comprising the lens of claims 8, 10 and 12. This claim for the headlight is not obvious from Iwase, et al, for the reasons stated above regarding claims 10 and 12.

Furthermore at least as far as the projection headlight claims go, Iwase, et al, is non-analogous art, which is not reasonably pertinent to the present invention. See M.P.E.P. 2141.01 (a).

First, the US classification numbers for Iwase, et al, are 359/819. Also the US field of search included 396/529, 530, 533 as well as 359/819. In contrast automobile headlights are generally classified in 362/512, 518, 522, and are thus

in an entirely different field of invention. A check on the International Classification numbers leads one to the same general conclusion.

This conclusion that the Iwase reference is in an entirely different field than the present invention agrees with the general understanding that Iwase, et al, discloses camera structure in the camera arts, which is an entirely different field from headlight structure in the motor vehicle arts.

In addition, there are significant structural differences between the plastic lens holder of Iwase, et al, and the sheet metal lens holder of the headlight claimed in the amended claim 14. The lens of the headlight claimed in the amended claim 14 and new claim 17 must be made of an inorganic material, particularly glass, in order to withstand the high temperatures used in the bright pressing process. Also the lens of the headlight claimed in claim 17 is especially suited for a compact headlight structure because of the features of the lens claimed in claim 10 and 12.

If a reference is not in the same field as a claimed invention, then the test of whether or not the reference is analogous art, according to the Federal Circuit Court of Appeals is:

“whether the reference is still reasonably pertinent to the particular problem with which the inventor is involved.” *In re Clay*, 23 U.S.P.Q. 2d 1058(Fed. Cir. 1992){underlining for emphasis is ours}

In the case of the present invention the object of invention claimed in claim 14 is to provide a headlight assembly for a motor vehicle with a lens that does not need to be finished by grinding and polishing (see page 2, lines 5 to 10, of

applicants' specification). However there is nothing in lwase, et al, that would help one design headlight assemblies, which are subject to high temperatures in operation and impacts when the vehicle is operated. There is nothing in lwase, et al, which would suggest bright pressing a lens for a headlight to avoid grinding during finishing.

Thus it is respectfully submitted that lwase, et al, is non-analogous art for the headlight claims 14, 15 and 17. A reference that is non-analogous art for a claimed invention cannot be employed under 35 U.S.C.103 (a) to establish a case of prima facie obviousness of the claimed invention. For example, the Federal Circuit Court of Appeals has said:

“The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness.”

***In re Oetiker***, 24 U.S.P.Q. 2d 1443, 1446 (Fed. Cir. 1992).

For the foregoing reasons and because of the changes in amended claim 14, withdrawal of the rejection of claims 8 to 15 under 35 U.S.C. 103 (a) over lwase, et al, is respectfully requested.

Also it is respectfully submitted that new claim 17 should not be rejected under 35 U.S.C. 103 (a) over lwase, et al.



### III. Other Prior Art

Nomura, et al; Jewers, et al; and US 2002/0109925 do not disclose either projection headlights for vehicles or lenses for projection headlights. Nomura, et al, disclose a plastic lens for optical applications. Jewers, et al, disclose an optical element for a projection television, but without a supporting edge equivalent to applicants' supporting edge. The published application discloses an optical lens for focusing laser beams onto a CD with a protective member formed of elastic material, such as rubber.

None of these references alone or together can be used to establish a case of *prima facie* obviousness of the subject matter of any of claims 8 to 17.

### IV. Information Disclosure Statement

Two prior art references, the "Patent Abstract of Japan" references, were listed on the Information Disclosure Statement filed with the original application papers on October 6, 2004.

A copy of this Information Disclosure Statement that was returned with the Office Action of October 18, 2005 did not indicate that these English language abstracts were considered. The appropriate boxes next to the listing of these references on the IDS form were not initialed by the Examiner.

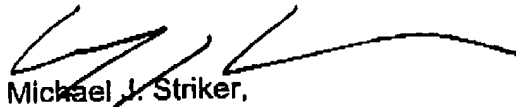
Please return another copy of this Information Disclosure Statement, which shows that these "Patent Abstracts of Japan" references were considered,

with the appropriate boxes on the IDS form initialed by the Examiner.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,



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